

**REMARKS**

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Claims 1 through 14 are pending in the case.

Examiner has rejected claims 1 through 14.

Claims 1 through 9 and 14 have been amended.

**Rejection under 35 U.S.C. § 102 (e)**

Examiner has rejected claims 1 through 14 under 35 U.S.C. § 102 (e) as being anticipated by USPN 6,671,718 (Meister). Applicant has amended the claims to increase clarity. Applicant respectfully traverses the rejection as to the claims as amended.

**Criteria for a Rejection under 35 U.S.C. § 102**

The criteria for a rejection under 35 U.S.C. § 102 has been clearly defined by the courts and confirmed by the U.S. Patent and Trademark Office. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Examiner has failed to show that each and every element set forth in the claims is found either expressly or inherently in Meister. Based on this, Applicant is traversing the rejections of the claims.

Below, Applicant points out subject matter within each independent claim that is not disclosed by Meister. On the basis of this, Applicant believes all the claims are patentable over Meister.

#### Independent Claim 1

Claim 1 sets out a method by which an electronic mail system sends an electronic message. Step (a) sets out that the electronic mail system, in preparation for sending an e-mail message, checks a field of the e-mail message used to specify addresses to be removed by the electronic mail system from a "To" field. The electronic system removes from any addresses specified in the "To" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from the "To" field. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from a "To" field of an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the e-mail message used to specify addresses to be removed from the "To" field.

Examiner has argued that in Meister a "Modify Addresses" control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at

column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 1 of the present case.

For example, step (a) of claim 1 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from a "To" field. The modify addressees control 46 does not disclose or suggest such a field of an e-mail message.

Likewise, step (a) of claim 1 sets out that the electronic system removes from any addresses specified in the "To" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from the "To" field. This is not disclosed or suggested by the modify addressees control 46 disclosed in Meister.

#### Independent Claim 8

Claim 8 sets out a method by which an electronic mail system sends an electronic message. Step (a) sets out that the electronic mail system, in preparation for sending an e-mail message, checks a field of the e-mail message used to specify addresses to be removed by the electronic mail system from all address fields. The electronic system removes from any addresses specified in a "To" field, a "Cc" field and a "Bcc" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from all address fields. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from address fields of an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the e-mail message used to specify addresses to be removed from any address field.

Examiner has argued that in Meister a "Modify Addresses" control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 8 of the present case.

For example, step (a) of claim 8 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from all address fields. The modify addressees control 46 does not disclose or suggest such a field of an e-mail message.

Likewise, step (a) of claim 8 sets out that the electronic system removes from any addresses specified in a "To" field , a "Cc" field and a "Bcc" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from all address fields. This is not disclosed or suggested by the modify addressees control 46 disclosed in Meister.

#### Independent Claim 9

Claim 9 sets out an electronic mail system for generating a message for being sent electronically. The message includes a field used to specify, to the

electronic mail system, addresses to be removed from the “To” field in preparation for sending the message. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from a “To” field of a message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the message used to specify addresses to be removed from the “To” field.

Examiner has argued that in Meister a “Modify Addresses” control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 9 of the present case.

Particularly, claim 9 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from a “To” field. The modify addressees control 46 does not disclose or suggest such a field of an e-mail message.

#### Independent Claim 14

Claim 14 sets out an electronic mail system for generating a message for being sent electronically. The message includes a field used to specify, to the electronic mail system, addresses to be removed from the address fields in

preparation for sending the message. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from all fields of the message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the message used to specify addresses to be removed from the address fields of the message.

Examiner has argued that in Meister a "Modify Addresses" control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 14 of the present case.

Particularly, claim 14 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from address fields of a message. The modify addressees control 46 does not disclose or suggest such a field of a message.

**Conclusion**

Applicant believes the Amendment has placed the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,  
PHYLLIS A. ELLENDMAN

By Douglas L Weller  
Douglas L Weller  
Reg. No. 30,506

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Santa Clara, California  
(408) 985-0642